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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|-------------------------------------|------------------|
| 10/525,714 | 12/08/2005 | Yuji Segawa | 09812.0373 | 5948 |
| 22852 | 7590 | 10/20/2008 | | |
| FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413 | | | EXAMINER BHAT, NARAYAN KAMESHWAR | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 1634 | |
| | | | MAIL DATE | DELIVERY MODE |
| | | | 10/20/2008 PAPER | |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/525,714

Applicant(s)

SEGAWA ET AL.

Examiner

NARAYAN K. BHAT

Art Unit

1634

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 29 September 2008 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: None.
Claim(s) objected to: _____.
Claim(s) rejected: 3-21 and 24-30.
Claim(s) withdrawn from consideration: 22, 23 and 31.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
13. ☐ Other: _____.

/Narayan K. Bhat/
Examiner, Art Unit 1634

/BJ Forman/
Primary Examiner, Art Unit 1634

Continuation of 11, does NOT place the application in condition for allowance because Applicant's amendments to claim 24 requiring counter electrodes disposed in the reaction region, each of the counter electrodes having a first surface facing the reaction region and floating-potential electrodes dispersed in a matrix layout between the counter electrodes, each of the floating-potential electrodes having a second surface facing the reaction region wherein the second surface is narrower than the first surface would also require further search and considerations. Furthermore, Applicant's amendments to claims 8 and 18 requiring the energized scanning electrode and a second scanning electrode adjacent to the energized scanning electrode are bridged by nucleotide probes immobilized between the energized scanning electrode and the second scanning electrode would require further search and considerations. Therefore, amendments to the claims are not entered.

Claim rejections under USC 102(e):

Applicant's arguments based on the amended claim 24 are moot because amendments to the claim 24 are not entered (See Remarks, pg. 11, last paragraph and pg. 12).

Claim rejections under USC 103(a):

Applicant's argues that "Zenhausen, Sato and Eichen alone or combined, fail to teach at least the adjacent electrodes being bridged by nucleotide probes" (Remarks, pg. 13, lines 16-17). This argument is not persuasive because as Applicants noted, Eichen teaches electrodes 104 and 105 are bridged by target 114 (Remarks, pg. 14, line 1).

Applicants argue that "Eichen does not teach electrodes 104 and 106 are adjacent electrodes" (Remarks, pg. 14, line 2). This argument is not persuasive for the following reasons.

Eichen et al explicitly teaches adjacent electrodes. The instant specification does not provide limiting definition for the phrase 'adjacent electrode' so as to define the adjacent electrode over the electrode illustrated by Eichen. Absent limiting definition, claims are given broadest reasonable interpretation and given the broadest reasonable interpretation, the opposing electrodes of Eichen et al are encompassed by the claimed adjacent electrodes.

Applicant argues that "Eichen et al cannot teach dielectrophoresis means for migrating the stretched nucleotide probes toward a pair of adjacent electrodes of the scanning electrodes by a non-uniform electric field generated by applying a voltage between the adjacent electrodes, wherein the adjacent electrodes are bridged by nucleotide probes immobilized between the adjacent electrodes" (Remarks, pg. 14, paragraph 2). This argument is not persuasive because claim 3 is rejected using Zenhausen et al, Sato et al and Eichen et al. As described in the final office action, Zenhausen et al teaches dielectrophoretic means for migrating nucleotide probes, Sato et al teaches stretching probes and Eichen et al teaches bridging the nucleotide probes immobilized on the adjacent electrodes. Applicants have acknowledged that Eichen et al teaches target, i.e., nucleic acid probe bridges the adjacent electrodes (pg. 14, line 1). Furthermore, Applicants have not provided any support evidence for why the bridging nucleotide probes by another nucleic acid probe would not work. Since Zenhausen et al, Sato et al and Eichen et al teaches all the structural features of sensor chip recited in claim 3, Applicants arguments are not persuasive.

Applicants arguments based on the amended claims 8, 14, 18, 24 and their dependent claims are moot because amendments to said claims are not entered (See Remarks, pgs. 15-17).

Double Patenting:

Non statutory obviousness-type double patenting rejections over claims of copending '940 and '977 applications are maintained. Applicants have not traversed the rejection.